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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/782,451

02/19/2004

Hans-Peter Foser

IVd15US

5190

7590
John C. Thompson
69 Grayton Road
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09/28/2009

EXAMINER

BALLINGER, MICHAEL ROBERT

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

09/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/782,451	Applicant(s) FOSER ET AL.	
	Examiner MICHAEL R. BALLINGER	Art Unit 3732	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): claims 2, 12, 16, 25 and 28 under 35 U.S.C. 112, 2nd paragraph.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-6, 9-11, 14, 16, 17, 20-22 and 26.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

/Cris L. Rodriguez/
 Supervisory Patent Examiner, Art Unit 3732

/Michael R Ballinger/
 Examiner, Art Unit 3732

Continuation of 11. does NOT place the application in condition for allowance because: The amendments and arguments submitted 9/9/09 overcome the 35 U.S.C. 112, second paragraph rejections outlined in the office action dated 7/10/09. Additionally, the amendments and arguments overcome a portion of the 35 U.S.C. 112, first paragraph rejection. However, claims 1-6, 9-11, 14, 16-17, 20-22, 26 stand rejected under 35 U.S.C. 112, first paragraph for the reasons outlined below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1-6, 9-11, 14, 16-17, 20-22, and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites the limitation "the interconnecting material being so designed and constructed that a firing of the assembly of the base structure, over structure, and interconnecting material can be omitted". Similarly, claim 20 recites the limitation "the method not requiring a firing of the base structure, interconnecting material and over structure." These, limitations, (i.e., that a firing can be omitted or is not required) are not adequately supported in the original disclosure. The Examiner notes, page 4, lines 12-13 of the specification states "A time-consuming firing of the assembly can be omitted which favorably benefits a reduction of the cycle time in the dental laboratory." Clearly omitting a "time consuming firing" is different than omitting "firing" altogether. Therefore, the original disclosure does not describe "omitting firing" or "not requiring firing" in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention at the time the application was filed.

Response to Arguments

On page 7 of the remarks filed 9/9/09 Applicant has argued "There is nothing in the text of this application which indicates that there is a firing. Furthermore, applicant has stated that his process eliminates a time consuming firing. Any firing is time consuming." The Examiner respectfully disagrees. As noted above, it is the Examiner's position that "omitting firing" is different than omitting a "time consuming firing". The Examiner also disagrees with Applicant's assertion that "any firing is time consuming." Specifically, the Examiner points to paragraph 14 of the office action dated 11/10/08, in which the Examiner clearly discusses the "firing" of the prior art to Braiman as not a "time consuming firing" (see e.g., Braiman, column 3, line 40). Applicant's argument that "the recitation concerning firing is in the nature of a whereby clause. In that the examiner is clearly in error for objecting to this facet of the claims". The Examiner respectfully disagrees, and notes, the patentability of a claim recitation over the prior art (i.e., under 35 U.S.C. 102 and 103) is immaterial to the analysis under 35 U.S.C. 112, first and second paragraph. In other words, whether or not a claim limitation is required or is simply preferred in a particular embodiment has no bearing on the issue of new matter, the mere inclusion of the new matter limitation renders the claim unpatentable. In the instant case the Examiner maintains claims 1 and 20 include subject matter not supported by the original disclosure. Therefore, the claims stand rejected under 35 U.S.C. 112, first paragraph.